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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/049,515	06/14/2002	Gregory D. Plowman	038602-1320	4070
22428	7590	06/03/2004	EXAMINER	
FOLEY AND LARDNER SUITE 500 3000 K STREET NW WASHINGTON, DC 20007			PROUTY, REBECCA E	
			ART UNIT	PAPER NUMBER
			1652	

DATE MAILED: 06/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/049,515

**Applicant(s)**

PLOWMAN ET AL.

**Examiner**

Rebecca E. Prouty

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-23 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_.

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Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1-5 and 12, drawn to polynucleotides encoding a dual specificity phosphatase and method of use thereof.

Group II, claim(s) 6-8 drawn to a dual specificity phosphatase.

Group III, claim(s) 9 and 10, drawn to antibodies to a dual specificity phosphatase.

Group IV, claim(s) 11, drawn to methods of screening for an modulator of a dual specificity phosphatase.

Group V, claim(s) 13-17, drawn to methods of treating with a modulator of a dual specificity phosphatase.

Group VI, claim(s) 18-20, drawn to methods of diagnosing a disease using hybridization to a polynucleotide encoding a dual specificity phosphatase.

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Group VII, claim(s) 21-23, drawn to methods of diagnosing a disease by detecting sequence variations in a polynucleotide encoding a dual specificity phosphatase.

For each of inventions I-VII above, restriction to one of the following is also required under 35 USC 121 and 372.

Therefore, election is required of one of inventions I-VII and one of inventions (A)-(T).

(A). protein of SEQ ID No: 2 or a nucleic acid encoding SEQ ID No: 2.

(B). protein of SEQ ID No: 4 or a nucleic acid encoding SEQ ID No: 4.

(C). protein of SEQ ID No: 6 or a nucleic acid encoding SEQ ID No: 6.

(D). protein of SEQ ID No: 8 or a nucleic acid encoding SEQ ID No: 8.

(E). protein of SEQ ID No: 10 or a nucleic acid encoding SEQ ID No: 10.

(F). protein of SEQ ID No: 12 or a nucleic acid encoding SEQ ID No: 12.

(G). protein of SEQ ID No: 14 or a nucleic acid encoding SEQ ID No: 14.

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(H). protein of SEQ ID No: 16 or a nucleic acid encoding  
SEQ ID No: 16.

(I). protein of SEQ ID No: 18 or a nucleic acid encoding  
SEQ ID No: 18.

(J). protein of SEQ ID No: 20 or a nucleic acid encoding  
SEQ ID No: 20.

(K). protein of SEQ ID No: 22 or a nucleic acid encoding  
SEQ ID No: 22.

(L). protein of SEQ ID No: 24 or a nucleic acid encoding  
SEQ ID No: 24.

(M). protein of SEQ ID No: 26 or a nucleic acid encoding  
SEQ ID No: 26.

(N). protein of SEQ ID No: 28 or a nucleic acid encoding  
SEQ ID No: 28.

(O). protein of SEQ ID No: 30 or a nucleic acid encoding  
SEQ ID No: 30.

(P). protein of SEQ ID No: 32 or a nucleic acid encoding  
SEQ ID No: 32.

(Q). protein of SEQ ID No: 34 or a nucleic acid encoding  
SEQ ID No: 34.

(R). protein of SEQ ID No: 38 or a nucleic acid encoding  
SEQ ID No: 38.

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(S). protein of SEQ ID No: 40 or a nucleic acid encoding  
SEQ ID No: 40

(T). protein of SEQ ID No: 42 or a nucleic acid encoding  
SEQ ID No: 42.

The inventions listed as Groups I(A)-VII(T) do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: The polynucleotides as claimed in Groups I(A)-I(T), proteins of Groups II(A)-II(T), and antibodies of Groups III(A)-III(T) are each unrelated and chemically distinct entities. The only shared technical feature of these groups is that they all relate to nucleic acids encoding dual specificity phosphatases. However this shared technical feature is not a special technical feature as defined by PCT Rule 13.2 as it does not define a contribution over the art. Tonks et al. (W0 99/02704, Reference A1 of applicants IDS of 3/14/02) and Muda et al. (Reference A2 of applicants IDS of 3/14/02) each teach nucleic acids encoding dual specificity phosphatases. Furthermore, the polynucleotides of Group I(A)-I(T) do not share unity with the proteins of Groups II(A)-II(T), respectively, as the proteins of groups I(A)-I(N) do not constitute a "special technical feature" as

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defined by PCT Rule 13.2, as they do not claim a feature which defines a contribution over the prior art as a protein within Groups II(A)-II(T) is encoded by the polynucleotides of EMBL Accession Nos. AA023073 and AA028820. The methods of Groups IV(A)-IV(T) and V(A)-V(T) do not share any technical feature with Groups I(A)-I(T) as the polynucleotides of Groups I(A)-I(T) are neither made nor used by the methods of Groups IV(A)-IV(T) and V(A)-V(T). The methods of Groups VI(A)-VI(T) and VII(A)-VII(T) do not have unity of invention with Groups I(A)-I(T) as Groups I(A)-I(T) already include a method of use of the polynucleotides which comprises unrelated steps to the methods of Groups VI(A)-VI(T) and VII(A)-VII(T) and 37 CFR 1.475 does not provide for the inclusion of multiple methods of use within the main invention.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim

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remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rebecca Prouty, Ph.D. whose telephone number is (571) 272-0937. The examiner can normally be reached on Monday-Friday from 8:30 to 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathapura Achutamurthy, can be reached at (571) 272-0928. The fax phone number for this Group is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-1600.



Rebecca Prouty  
Primary Examiner  
Art Unit 1652